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REMARKS

By this Amendment, claims 8, 12, 14, and 38 have been amended. Claim 39 has been cancelled. Claims 43 and 44 have been newly added. Therefore, claims 1, 2, 4-6, 8, 12, 14, 15, 17-19, 21, 25-27, 29-31, 33, 37, 38, and 40-44 are pending. Support for the instant amendments and newly added claims are provided throughout the as-filed Specification. Thus, no new matter has been added. In view of the foregoing amendments and following comments, allowance of all the claims pending in the application is respectfully requested.

FINDINGS OF FACT AND PRINCIPLES OF LAWS

The Examiner makes numerous contentions and characterizations in the "Findings of Fact" and "Principles of Laws" sections of the Office Action. Applicants disagree with many of these assertions, however will only address those relevant to the rejection of claims specifically addressed in this response. Under no circumstances shall any of the Examiner's findings be construed as agreed to unless Applicants explicitly state their acquiescence.

For example, the Examiner alleges that independent claim 14 is claimed functionally, in terms of intended use, instead of structurally. Without agreeing to the propriety of this allegation, and solely for the purpose of expediting prosecution, claim 14 has been amended to further clarify the invention.

REJECTIONS UNDER 35 U.S.C. § 102/103

Claims 1, 2, 4-6, 8, 12, 14, 15, 17-19, 21, 25-27, 29-31, 33, 37, 38, and 40-42 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by, or in the alternative under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No.6,029,195 to Herz *et al.* (hereinafter "Herz").

Rejections of Independent Claims 1, 14, and 27 under 35 U.S.C. 102

Applicant traverses the rejections under 35 U.S.C. § 102(b) for at least the reason that Herz neither explicitly nor impliedly discloses all of the features of the claimed invention. "A prior art reference anticipates a patent claim if the reference discloses, either expressly or inherently, all of the limitations of the claim." *Metabolite Laboratories, Inc. v. Laboratory*

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Corporation of America Holdings, 370 F.3d 1354, 1367, 71 U.S.P.Q. 2d (BNA) 1081, 1090 (Fed. Cir. 2004) (quoting *EMI Group N. Am., Inc. v. Cypress Semiconductor Corp.*, 268 F.3d 1342, 1350, 60 U.S.P.Q. 2d (BNA) 1423, 1429 (Fed. Cir. 2001) (citation omitted)).

More particularly, Herz fails to disclose at least the feature of “determining if [a] second user appears to be interested in the received topic based on the monitored activities of the second user and based on the associated information,” (emphasis added) as recited in independent claim 1, for example.

The examiner generally relies on Herz at Column 67, lines 40-55 to allege that a system which “scans the transcripts of all real-time spoken or written discussions on the network that are currently in progress and designated as public... and employs [a] news-clipping technology to rapidly identify and notify users who may be interested in joining an ongoing discussion...” or “scans the transcripts of all real time spoken, written, or acoustic (e.g., audio or video streaming data) on the network that are currently in progress and employs news clipping technology to rapidly identify content which is most appropriate for particular advertisement or promotion that may pertain to the target object profile” corresponds to this feature of the claimed invention. However, the Examiner ignores the antecedent basis for “the received topic”, which may be found in the earlier recited feature “receiving a topic of interest and associated information from a first user on a user interface on a first computer.” There is no indication in the cited portion of the Herz reference that the automatic scanning of in-progress real-time spoken or written discussions, or transcripts thereof, comports with determining *a second* user’s interest in the same topic received “from a first user on a first computer.”

Independent claims 14 and 26 recite similar features as set forth in independent claim 1. As such, the rejection of these claims is likewise improper and must be withdrawn for at least the same reasons.

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Rejections of Independent Claims 1, 14, and 27 under 35 U.S.C. 103

Applicant traverses the 35 U.S.C. § 103(a) rejection for at least the reason that the Examiner has failed to establish a *prima facie* case of obviousness.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). Obviousness is a question of law based on the following underlying factual inquiries: “(a) the scope and content of the prior art; (b) the differences between the prior art and the claims at issue; (c) the level of ordinary skill in the art; and (d) objective evidence of nonobviousness.” *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 958, 1 U.S.P.Q.2d 1196, 1197 (Fed. Cir. 1986) (citing *Graham*, 383 U.S. at 17). “Against this background, the obviousness or nonobviousness of the subject matter is determined.” *Graham*, 383 U.S. at 17.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). It is also well established that “the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) (discussing *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984)).

In the instant application, the Examiner has failed to establish a *prima facie* case of obviousness. In particular, Herz does not appear to disclose, teach or suggest “determining if [a] second user appears to be interested in the received topic based on the monitored activities of the second user and based on the associated information” as discussed above with respect to the 35 U.S.C. § 102(b) rejection.

Furthermore, the Examiner alleges that “the applying of the customer profiling and identifying of desirable objects to other business issues or strategies would have been obvious

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as mere using the same system for other similar business issues." Office Action, page 11. Applicants disagree with this assertion for at least the following reasons.

First, the mere allegation that Herz could be used in certain way does not render claimed invention obvious. Indeed, "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). Tellingly, the Examiner has not make such a showing.

Second, even assuming *arguendo* that aspects of Herz could be applied to other business issues (which Applicant does not concede), this alone does not disclose, teach, or suggest "receiving a topic of interest and associated information from a first user on a user interface on a first computer," which may be used to notify the second user, as is recited in claim 1. As discussed above, the Examiner simply fails to identify both first and second users in Herz in the manner that the claimed invention recites.

Independent claims 14 and 26 recite similar features as set forth in independent claim 1. As such, the rejection of these claims is likewise improper and must be withdrawn for at least the same reasons.

Rejections of Dependent Claims

Claims 2, 4-6, 8, 12, 15, 17-19, 21, 25, 27, 29-31, 33, 37, 38, and 40-42 depend from and add features to one of independent claims 1, 14, and 26. As such the rejection of these claims is likewise improper at least for the reasons discussed above, as well as for the further features they recite.

For example, the Examiner alleges that in dependent claims 8 and 12, the phrases "to receive information" and "to be added" are mere intended use of the created request, and have no patentable weight. Furthermore, the examiner alleges that the type of information and descriptions are considered non-functional descriptive material. Without agreeing to the propriety of the allegations, and solely for the purpose of expediting prosecution, claims 8 and 12 have been amended to clarify aspects of the invention.

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As another example, as for dependent claim 38, the examiner alleges that the claim is considered as non-functional descriptive material. Without agreeing to the propriety of this allegation, and solely for the purpose of expediting prosecution, claim 38 has been amended to clarify this aspect of the invention.

NEW CLAIMS

Applicant has added new dependent claims 43 and 44. Support for these new claims may be found at least in paragraphs 1 and 2 of page 5 of the Specification as filed. These claims are allowable at least for the reason that they depend from and add features to independent claim 1, which is allowable at least for the reasons discussed above, as well as for the further features they recite.

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CONCLUSION


Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.


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Respectfully submitted,

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